

## **REMARKS**

### **Claim Rejections**

Claims 1-37 stand rejected under 35 U.S.C. § 101.

Claims 1-8, 15-22 and 28-45 stand rejected under 35 U.S.C. § 103(a) as unpatentable over U.S. Publication No. 2003/0220139 (Peterson) in view of U.S. Publication No. 2003/0195031 (O'Donovan et al.).

Claims 9-14 and 23-27 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Peterson in view of O'Donovan et al. and further in view of U.S. Publication No. 2003/0013527 (Rowe).

### **Claim Amendments**

Claims 1-37 have been amended to eliminate the rejection under 35 U.S.C. § 101. All the claims have also been amended to further patentably distinguish over the cited references.

### **The Cited References**

Peterson discloses a gaming machine winning information viewing system that includes a gaming machine coupled to a video display monitor. The video display monitor displays current or historical jackpot winning information from the gaming machine. (Abstract). A central control unit 35 collects jackpot winning information and adds the time and date of the last jackpot awarded and the number of jackpots awarded within a selected time period and their amounts. The control unit 35 also transmits optional gaming machine identification data to a video display monitor 30. (¶¶0018-0019).

O'Donovan discloses a player configurable video gaming machine in which a player may select one or more configuration inputs to play a previously configured default game or to create a new game configuration. (Abstract). More specifically, O'Donovan is directed to a method and device for implementing a menu driven player configurable video game. As such, a player is able to input various configuration criteria for a video game. (¶¶0016-0018).

Rowe et al. discloses a system for providing information to a player or players of a game or gaming machines. (Abstract). The type of information provided to a player may vary. The information may comprise text, images, sounds, video clips or streaming video. (¶0067).

### **Applicant's Claimed Invention Would Not Have Been Obvious**

The following factual inquiries must be considered in any obviousness evaluation: the scope and content of the prior art, the differences between the claimed invention and the prior art, the level of ordinary skill in the pertinent art and evidence of any secondary considerations. To establish a *prima facie* case of obviousness, it is axiomatic that the prior art, either alone or in combination, must disclose each and every element of the claimed invention. As stated in the M.P.E.P., “[t]o reject a claim . . . Office personnel must articulate the following: (1) a finding that the prior art included each element claimed, although not necessarily in a single prior art reference, with the only difference between the claimed invention and the prior art being the lack of actual combination of the elements in a single prior art reference.” M.P.E.P. §2143A.

Moreover, “[t]he rationale to support a conclusion that the claim would have been obvious is that all claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination yielded nothing more than predictable results to one of ordinary skill in the art.” *Id.* Also, some articulated reasoning with rational underpinnings must be provided to support a *prima facie* case of obviousness.

The combination of Peterson and O'Donovan et al. does not result in Applicant's claimed invention as set out in independent claims 1, 35, 38, 41 and 45. Thus, a *prima facie* case of obviousness has not been out.

Amended claim 1, for example, calls for a method for generating a report concerning gaming machine past payout data. The report includes comparative past payout data. The report is based on historical payout data and selection criteria chosen by a player of a gaming machine. The report allows the player to identify a gaming machine from among a plurality of gaming machines that is more likely to produce an outcome desired by the player. For example, a player may prefer to play a high paying or low paying machine based on a belief that such a machine is are more likely to hit a jackpot.

Peterson discloses displaying real time jackpot winning information to players. This information is displayed to a player via a video display monitor. (¶¶0008, 0009, 0018).

O'Donovan et al. discloses a method for implementing a player configurable video gaming machine. If a particular modification impacts the return of a pre-set pay table of a gaming machine, other configurations of the gaming machine are adjusted to maintain the return of the pre-set pay table. (¶¶0002, 0009-0010),

Neither reference, however, discloses maintaining a record of past gaming machine payout data for the purpose of generating a report based on a player's selection criteria and

including comparative past payout data. Instead, in Peterson, jackpot winning information is displayed in real time, and no report, based on a player's selection criteria, is generated including comparative past payout data.

Additionally, neither reference discloses accepting selection criteria inputted by a player for the purpose of generating a report which allows the player to identify a gaming machine that is more likely to produce an outcome desired by the player. Rather, in O'Donovan et al., a game configuration may be selected by a player. However, a pay table of a gaming machine must be maintained and no player input is used as selection criteria for the purpose of generating a report based on historical payout data.

Since amended claim 1 recites features not disclosed or suggested in any of the cited references, considered alone or in combination, claim 1 would not have been obvious in view of the cited references. The other independent claims recite features similar to those recited in claim 1. Therefore, those claims would not have been obvious for at least the same reasons as claim 1. The dependent claims include, by virtue of their dependency, the features of the independent claims on which they are based. Thus, the dependent claims would not have been obvious for at least the same reasons as their respective independent claims.

#### **Applicant's Claimed Invention Is Directed To Statutory Subject Matter**

Claims 1-37 have been amended so as to be tied to particular apparatus. Therefore, amended claims 1-37 are directed to statutory subject matter.

#### **Conclusion**

In view of the foregoing, it is respectfully submitted that all the claims are now in condition for allowance. Accordingly, allowance of the claims at the earliest possible date is requested.

If prosecution of this application can be assisted by telephone, the Examiner is requested to call Applicant's undersigned attorney at (510) 663-1100.

If any fees are due in connection with the filing of this amendment (including any fees due for an extension of time), such fees may be charged to Deposit Account No. 504480 (Order No. IGT1P328).

Date: March 9, 2010

Respectfully submitted,

Weaver Austin Villeneuve & Sampson LLP

/William J. Egan, III/

William J. Egan, III

Reg. No. 28,411